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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/627,952	07/24/2003	Jin-Tang Dong	4239-66335-01	2427

7590 01/30/2006

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EXAMINER

BAUSCH, SARAE L

ART UNIT

PAPER NUMBER

1634

DATE MAILED: 01/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



## DETAILED ACTION

### *Election/Restrictions*

- I. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claim 1, drawn to method of detecting the presence of malignant cancer as it relates to comparing a nucleic acid, classified in class 435, subclass 6.
  - II. Claim 1, drawn to method of detecting the presence of malignant cancer as it relates to comparing a protein, classified in class 435, subclass 7.1.

The inventions are distinct, each from the other because of the following reasons:

Inventions of group I and II are biologically and functionally different and distinct from each other and thus one does not render the other obvious. The methods of group I comprise steps which are not required for or present in the method of group II: comparing KAI1 mRNA sequence to wild type sequence (group I) and comparing KAI1 protein sequence to wild-type protein (group II). The end results of the methods are different: detecting a nucleic acid (group I) and detecting a protein (group II). Additionally, the inventions of groups I and II are patentably distinct because they use different products having different structures and functions. The nucleic acid of group I is composed of deoxyribonucleotides linked by phosphodiester bonds and assumes the form of a double helix. The polypeptide of group II is composed of amino acids linked by peptide bonds and can assume complex tertiary structures. Thus, the operation, function, and effects of these different methods are different and distinct from each other. Therefore, the inventions of these different groups are patentably distinct. Furthermore, searching the inventions of group I and II would impose a serious burden because the search for

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a comparing nucleic acid sequence is not coextensive with a search for comparing a protein sequence.

2. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

3. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sarae Bausch whose telephone number is (571) 272-2912. The examiner can normally be reached on M-F 10am-7pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones can be reached on (571) 272-0745. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

  
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